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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/658,522   | 09/08/2003  | Raymond Bertholet    | 88265-6925          | 1947             |
| 29157  | 7590        | 07/14/2006           | EXAMINER            |                  |
| BELL, BOYD & LLOYD LLC<br>P. O. BOX 1135<br>CHICAGO, IL 60690-1135 |             |                      | SILVERMAN, ERIC E   |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |

1615

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |  |                     |  |
|------------------------------|------------------------|--|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> |  | <b>Applicant(s)</b> |  |
|                              | 10/658,522             |  | BERTHOLET ET AL.    |  |
|                              | <b>Examiner</b>        |  | <b>Art Unit</b>     |  |
|                              | Eric E. Silverman, PhD |  | 1615                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

### DETAILED ACTION

Applicants' amendment and remarks, filed 6/5/2006, have been received. Claims 1 – 19 are pending.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The rejection of claims 1 – 6 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is **withdrawn** in light of applicants' persuasive arguments.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of claims 7 – 16, 18, and 19 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is **withdrawn** in light of the amendment to claim 7.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 – 3, 5 – 7, 9, 1 – 19 **remain** rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,177,580 to Timmermann et al in combination with EP 0726321 to Barclay, for reasons of record and those discussed below.

### ***Response to Arguments***

Applicants' arguments have been fully considered, but are not persuasive.

In response to the argument that there is no motivation to combine the references, it is noted that Barclay provides this motivation by teaching the superiority of microorganism-based techniques over synthetic techniques.

With regard to the argument that the teachings are not physically combinable, for example, because the heating step in Timmermann might destroy the microorganisms of Barclay, this is not germane to the test for obviousness. Note the following quotation from MPEP 2145.

### **III. ARGUING THAT PRIOR ART DEVICES ARE NOT PHYSICALLY COMBINABLE**

"The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). See also *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983) ("[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review."); and *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973) ("Combining the teachings of references does not involve an ability to combine their specific structures.").

However, the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. See MPEP § 2143.01.

In this case, Applicant has alleged that the secondary reference would be rendered inoperable, however, as noted above, the relevant test is whether the *primary* reference would be rendered inoperable. Here there is no reason to think that the primary reference would be rendered inoperable.

In response to the argument that the references do not teach or suggest that the PUFAs are incorporated by at least 60% by weight, but that less than 10% of phosphorous in the biomass is present in the oil, it is noted that the teaching of "high yield" is deemed to meet this limitation, since high yield is understood to mean a yield (in this case of PUFA) of at least 60%, but more likely 80% or greater. With regard to the phosphorous, since no phosphorous is taught to be transferred into the oil, such is deemed absent.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

It is further noted that, with regard to the product claims, the recitation of "obtainable by" does not mean that the product must be obtainable by the recited steps. Claims 1 – 6 are not read as product by process claims. As such, Applicants' argument as it applies to these claims is largely a reading of limitations of the specification into the claims. Also, with regard to product claims 1 – 6, the limitation "the oil does not require any further purification before use" is understood to read on the final product, not on

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intermediate products which may be purified, for example by distillation, as recited in claim 12.

It is reemphasized that the critical aspect of Applicants' invention, extraction of arachadonic acid from a biomass with a carrier oil, such as an edible oil, is recited by Barclay on page 6, beginning on line 27 where it is recited that the "microorganisms can be broken or lysed and the lipids [arachadonic acid] recovered into edible oil".

Claims 9 and 10 **remain** rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,177,580 to Timmermann in combination with EP 0726321 to Barclay and in further view of Todd, of record, for reasons of record and those discussed below.

### ***Response to Arguments***

Applicant's arguments have been fully considered, but are not persuasive.

Applicant argues that Todd does not cure the supposed deficiencies of Timmermann and Barclay. These alleged deficiencies have been discussed, *supra*.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. CP 0 612 725 also teaches extraction of beneficial materials from a biomass using oils.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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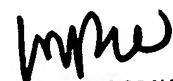
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric E. Silverman, PhD whose telephone number is 571 272 5549. The examiner can normally be reached on Monday to Friday 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571 272 8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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Art Unit 1615



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